IN THE UNITED STATES PATENT OFFICE

In re Application of: Ira Goldstein, et al.	)	Confirmation No.: 8828
Serial No.: 10/820,630	)	Examiner: Pachol, Nicholas C.
Filed: April 7, 2004	)	Group No.: 2625
For: DIGITAL DOCUMENTS, APPARATUS, METHODS AND SOFTWARE RELATING TO ASSOCIATING AN IDENTITY OF PAPER PRINTED WITH DIGITAL PATTERN WITH EQUIVALENT DIGITAL DOCUMENTS	)	HP Docket No.: 200208339-1

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF - PATENTS

Dear Sir:

This is an Appeal Brief in connection with the decision of the Examiner in the Office Action Dated April 30, 2009. It is respectfully submitted that the present application has been more than twice rejected. Each of the topics required in an Appeal Brief and a Table of Contents are presented herewith and labeled appropriately.

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(1) Real Party In Interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

(2) Related Appeals and Interferences

To the best of Appellants' awareness, there are no other appeals or interferences related to this case.

(3) Status of Claims

A complete listing of the claims with current status indicated is provided in the Claim Appendix beginning on page 18.

Claims 1-9, 12-19, 21, 23, 24, 52 and 72-74 -13 are pending in the present application.

Claims 10-11, 20, 22, 25-51 and 53-71 were previously canceled.

Claims 1-9, 12-19, 21, 23, 24, 52 and 72-74 stand finally rejected less than 35 USC §103(a).

The rejection of claims 1-9, 12-19, 21, 23, 24, 52 and 72-74 is appealed.

(4) Status of Amendments

No amendment has been filed subsequent to the Final Office Action dated April 30, 2009.

(5) Summary of the Claimed Subject Matter

Appellants' application includes the following independent claims.

1. (Previously Presented) A method of associating in computer memory **(105a, 502)** (i) a digital electronic version of printed human-discernible content **(105e, 362, 516)** of a printed document **(105b, 360)** comprising a sheet **(105c, 506)** having a machine-readable pattern **(364, 484)** adapted to enable the position of a digital pattern reading device to be determined and said human-discernible content **(105e, 362, 516)** with (ii) the identity of a sheet **(105c, 506)** upon which the content **(105e, 362, 516)** is printed, the method comprising:

printing the content **(105e, 362, 516)** onto a sheet **(105c, 506)** using a second printer **(110, 142, 424, 480, 508)**, said sheet **(105c, 506)** comprising a pre-patterned sheet **(105c, 506)** that has been pre-printed by a first printer **(140, 422)** with said pattern **(364, 484)** *(Appellants' specification initially ¶239 and FIG. 3c, ¶¶254-255 and FIG. 3a, ¶¶258-266 and FIGs. 4-4b, ¶¶271-272 and FIG. 6, ¶¶346-350 and FIGs. 20-21);*

transferring a machine-readable identity code **(152, 169, 162, 514)** between said second printer **(110, 142, 424, 480, 508)** and said sheet **(105c, 506)** at around the time of printing said content **(105e, 362, 516)** *(Appellants' specification ¶272-281 and FIG. 6, ¶285-286 and FIGs. 7-7a, ¶¶346-350 and FIGs. 20-21);*

and storing a correlation between said identity code **(152, 169, 162, 514)** and said digital electronic version **(105e, 362, 516)** in computer memory **(105e, 502)** *(Appellants' specification ¶¶272-281 and FIG. 6, ¶285-286 and FIGs. 7-7a, ¶¶346-350 and FIGs. 20-21).*

12. (Previously Presented) A method of associating in computer memory **(105a, 502)** a digital electronic version of printed human discernible content **(105e, 362, 516)** of a printed document **(105b, 360)** with an identity code **(152, 169, 162, 514)** adapted to identify said document **(105b, 360)**, the method comprising:

using a plurality of pages **(507)** of pre-patterned digital paper **(105c, 506)** that have been pre-printed by a first printer **(140, 422)** with a position-determining pattern **(364, 484)**, said pattern **(364, 484)** being adapted to enable a digital pen **(366)** to acquire information from said pattern **(364, 484)** to enable the position of said pen **(366)** on said pattern **(364, 484)** to be determined *(Appellants' specification initially ¶239 and FIG. 3c, ¶¶254-255 and FIG. 3a, ¶¶258-266 and FIGs. 4-4b, ¶¶271-272 and FIG. 6, ¶¶346-350 and FIGs. 20-21);*

printing said content (**105e**, **362**, **516**) on said digital paper (**105c**, **506**) using a second printer (**110**, **142**, **424**, **480**, **508**) *(Appellants' specification ¶239 and FIG. 3c, ¶¶258-266 and FIGs. 4-4b, ¶¶271-272 and FIG. 6, ¶¶346-350 and FIGs. 20-21);*

using said second printer (**110**, **142**, **424**, **480**, **508**) to be instrumental in conveying an identity code (**152**, **169**, **162**, **514**) to or from the paper (**105c**, **506**) *(Appellants' specification ¶¶272-281 and FIG. 6, ¶285-286 and FIGs. 7-7a, ¶¶346-350 and FIGs. 20-21);*

and associating in computer memory (**105a**, **502**), using said code (**152**, **169**, **162**, **514**) transferred, at the time of printing said content (**105e**, **362**, **516**) onto said pre-patterned paper (**105c**, **506**), a digital electronic version of said content (**105e**, **362**, **516**) with the identity code (**152**, **169**, **162**, **514**) for the particular sheet of digital paper (**105c**, **506**)upon which said content (**105e**, **362**, **516**) is printed*(Appellants' specification initially ¶239 and FIG. 3c, ¶¶254-255 and FIG. 3a, ¶¶272-281 and FIG. 6, ¶285-286 and FIGs. 7-7a, ¶¶346-350 and FIGs. 20-21).*

52. (Previously Presented) A method of combining pen strokes made with a digital pen (**366**) upon a digital sheet (**105b**, **360**) having pen position-determining pattern (**364**, **484**) printed upon it and human-discernible content (**105e**, **362**, **516**) printed upon it comprising:

printing said sheet (**105c**, **506**) with said pattern (**364**, **484**) in a pre-patterning operation with a first printer (**140**, **422**) to create a pre-patterned sheet *(Appellants' specification initially ¶239 and FIG. 3c, ¶¶254-255 and FIG. 3a, ¶¶258-266 and FIGs. 4-4b, ¶¶271-272 and FIG. 6, ¶¶346-350 and FIGs. 20-21);*

subsequently printing said content (**105e**, **362**, **516**) onto said pre-patterned sheet (**105c**, **506**) using a second printer (**110**, **142**, **424**, **480**, **508**) to create a content-printed digital sheet *(Appellants' specification ¶239 and FIG. 3c, ¶¶258-266 and FIGs. 4-4b, ¶¶271-272 and FIG. 6, ¶¶346-350 and FIGs. 20-21);*

transferring an identity code (**152**, **169**, **162**, **514**) between said second printer (**110**, **142**, **424**, **480**, **508**) and said sheet (**105c**, **506**) to enable the identity of said sheet (**105c**, **506**) to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code (**152**, **169**, **162**, **514**) occurring in the same time frame as printing said content onto said sheet (**105c**, **506**) *(Appellants' specification ¶272-281 and FIG. 6, ¶285-286 and FIGs. 7-7a, ¶¶346-350 and FIGs. 20-21);*

associating in computer memory (**105a**, **502**) a link between said identity code (**152**, **169**, **162**, **514**) and an electronic version of said content (**105e**, **362**, **516**) that was printed on said sheet (**105c**, **506**) *(Appellants' specification ¶239 and FIG. 3c, ¶272-281 and FIG. 6, ¶285-286 and FIGs. 7-7a, ¶¶346-350 and FIGs. 20-21);*

using a digital pen (**366**) to make pen strokes on said content-printed sheet (**105c**, **506**) (*Appellants' specification ¶¶254-255, FIG. 3a, ¶¶346-350 and FIGs. 20-21, ¶248, ¶¶250-251, ¶¶256, ¶¶269-270 and FIG. 5, ¶301 and FIG. 11, ¶311 and FIG. 13);*

conveying pen-acquired pen-position data, relating to the position of said pen (**366**) in said pattern (**364**, **484**) to a processor (**102a**, **370**, **488**, **413**, **509**) (*Appellants' specification* ¶234 and FIG. 3, *¶¶254-255 and FIG. 3a, ¶¶258-266 and FIGs. 4-4b,* ¶284 and FIG. 6a, *¶¶346-350 and FIGs. 20-21);*

using the digital pen (**366**) to acquire said identity code (**152**, **169**, **162**, **514**) from said content-printed sheet (**105c**, **506**) (*Appellants' specification ¶239 and FIG. 3c, ¶¶254-255 and FIG. 3a, ¶¶346-350 and FIGs. 20-21);*

the processor (**102a**, **370**, **488**, **413**, **509**) using the pen-acquired identity code (**152**, **169**, **162**, **514**), the pen (**366**) acquired pen-position data, and the link between said identity code (**152**, **169**, **162**, **514**) and said electronic version of said content (**105e**, **362**, **516**) to combine said pen strokes with said content (**105e**, **362**, **516**) *Appellants' specification ¶248, ¶¶250-251, ¶¶256, ¶¶269-270 and FIG. 5, ¶301 and FIG. 11, ¶311 and FIG. 13, ¶320-322 and FIG. 15, ¶¶254-255 and FIG. 3a, ¶¶346-350 and FIGs. 20-21).*

(6) Grounds of Rejection to be Reviewed on Appeal

The Final Office Action of April 30, 2009 raised the following grounds of rejection.

Accordingly, Appellants hereby requests review of this rejection in the present appeal.

a.) Claims 1-9, 12-19, 21, 23, 24 and 52 were rejected under 35 U.S.C. §103(a), as being unpatentable over US Patent 7,111,230 to Euchner et al, hereinafter "Euchner," in view of US Patent 6,915,281 to Coffy et al., hereinafter "Coffy."

b.) Claims 72-74 were rejected under 35 U.S.C. §103(a), as being unpatentable over Euchner in view of Coffy further in view of US Patent 7,050,181 to Korst et al., hereinafter "Korst."

(7) **Argument**

a.) **The rejection of claims 1-9, 12-19, 21, 23, 24 and 52 under 35 U.S.C. §103(a), as being unpatentable over Euchner in view of Coffy is unfounded and does not satisfy the requirements of prima facie obviousness.**

b.) The rejection of claims 72-74 under 35 U.S.C. §103(a), as being unpatentable over Euchner in view of Coffy further in view of Korst is unfounded and does not satisfy the requirements of prima facie obviousness.

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S._, 82 USPQ2d 1385 (2007):

> "Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP §2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the aforementioned *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results;
(B) Simple substitution of one known element for another to obtain predictable results;
(C) Use of known technique to improve similar devices (methods, or products) in the same way;
(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
(E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S._, 82 USPQ2d 1385 (2007).

In accordance with the above provisions, a review of the cited references Euchner, Coffy and Korst is therefore in order.

Before proceeding with such a review of the prior art references, a brief review of the present application might well aid in appreciating the distinct and advantageously patentable differences presented by the present invention.

With respect, attention is first directed to the recitation of Prior Art in the present application wherein it is discussed that although there is a desire to use one printer to print both the human discernible content and the Anoto-type digital patter at the same time, this desire has inherent disadvantage.

> "***That realization is a factor in making the present invention***. That realization is that if the pattern and text (content) are printed simultaneously on the same printer each user who desires to print out a document having a digital pattern needs access to a high-resolution printer capable or printing the position determining pattern to a resolution good enough to allow pen strokes to be captured. This is beyond the capability of many existing printers (e.g. 150 dpi may not be good enough). ***This means that hundreds of millions of legacy printers cannot be used with such a system***. Such a system would also place a high computational and memory burden on the printer and instructing PC. High-resolution printers that have sufficient resolution to print out the Anoto digital pattern are also often expensive." See Para 16, emphasis added.

The present application clearly and unambiguously sets forth that a First Printer establishes the digital pattern. This First Printer is a separate and distinct printer from the Second Printer. It is this Second Printer, ***not the First Printer*** that is used to provide the Human Readable Content. An Identity Code is also employed so as to correlate the digital pattern with the Human Readable Content.

As the present application presents multiple embodiments accompanied by multiple figure illustrations, the following table may be helpful in further identifying and clarifying the distinct elements, identified by first paragraph of introduction and associated figure.

FIRST PRINTER	**SECOND PRINTER**
high-resolution printer **140** - ¶271 FIG. 6 high-resolution laser printer **422** - ¶263 FIG. 4a	local printer **110** - ¶238 FIG. 3 low resolution printer **142** - ¶271 FIG. 6 low resolution ink jet printer **424** - ¶263, FIG. 4a printer **480** - ¶265 FIG. 4b printer **508** – ¶347 FIG. 21

SHEET pre-patterned digital paper **105c** - ¶239 FIG. 3c sheet of paper **506** - ¶347 FIG.21	**CONTENT** human discernible content **105e** - ¶239 FIG. 3c content **362** - ¶254 FIG. 3a human discernible content **516** – ¶347 FIG. 21
IDENTITY CODE identifier **152** - ¶272 FIG. 6 identifier **169** - ¶285 FIG. 7 identifier **162** - ¶272 FIG. 7a identity code **514** - ¶347 FIG. 21	

Moreover, to summarize, the present invention teaches that a First Printer provides pre-printed digital paper, the pages having a pattern sufficient for use by a digital pen to determine location of the pen upon the paper. A Second Printer, different from the First Printer, then provides Content. Because the Second Printer is different from the First Printer, an Identity Code is also used so as to establish a correlation between the paper and the Content.

Although other differences certainly exist as well, appreciating the above principles will aid in further understanding the distinctions over the prior art references.

Euchner clearly and unambiguously teaches repeatedly that **the same printer is used** to **print the digital paper (digital pattern) AND the document**. This point is stated no less than three times.

> "***A special printer is used to print both the digital paper and the document*** so that the electronic master document is associated with the printed hardcopy. The printer prints a digital paper identifier such as a carbon based dot pattern to provide a unique pattern space. The printer also prints the hardcopy document on the paper so that the electronic version of the document is associated with that particular pattern space." Col. 2, lines 24-31, emphasis added.
>
> "In an illustrative embodiment, ***a special printer is used to print both the digital paper and the document*** so that the electronic master document is associated with the printed hardcopy." Col. 4 lines 38-41, emphasis added.
>
> "In another alternative, a bitmap printer such as ***a laser printer or an inkjet printer is utilized to print both an underlying ANOTO pattern and a document***." Col. 7, lines 59-60, emphasis added.

Examiner's contention that Euchner permits one or more printers and one printer may establish the pattern and a different printer may establish the content is plane error. Regardless of how many printers may be in use, ***Euchner teaches that each must be a special printer so as to establish both the digital pattern and the content.***

The Examiner acknowledges that "Euchner does not teach said sheet comprising a pre-patterned sheet that has been pre-printed by a first printer with said pattern." See Final Office

Action Page 4, paragraph 4. However, Examiner is apparently missing an important aspect to this statement. Such misunderstanding is evidenced by Examiner's statement that Euchner teaches providing, "the identify of a sheet upon which the content is printed (Col 4, lines 39-45); printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed by a printer with said pattern (Col 5, Lines 11-16)." Final Office Action Page 4, paragraph 1. This statement is in error.

The Examiner is in error in the interpretation of the first citation.

> "In an illustrative embodiment, ***a special printer is used to print both the digital paper and the document*** so that the electronic master document is associated with the printed hardcopy. *The printer prints a digital paper identifier such as a carbon based dot pattern to provide a unique pattern space.* The printer also prints the hardcopy document on the paper so that the electronic version of the document is associated with that particular pattern space." (Col 4, lines 39-45, emphasis added).

At least two points must be noted with respect to this passage:

1 – Clearly one (1) printer is used for providing both the digital paper and the document.

2 – the dot pattern is providing the unique pattern space. This is NOT a unique identifier, e.g. an identity code that exists in addition to the digital pattern.

The Examiner is also in error in the interpretation of the second citation.

> "Printer **110** ***may concurrently encode paper 120 with digital pattern information when printing the hardcopy documents* 125**. ***Alternatively, paper 120 may be preprinted with digital pattern information and*** the paper is associated with the document.
>
> In this system, ***a special printer* 110** prints multiple hardcopies **125** of the original version of the document." Col 5, lines 12-18, emphasis added.

Euchner has specifically stated that it is *A SPECIAL PRINTER* that prints the digital pattern ***and*** the document. That Euchner states the digital pattern may be preprinted is not disputed, however based on the teachings set forth it must be undisputed as well that whether preprinted or not Euchner clearly and unambiguously teaches that it is **the same printer**. Whether the digital pattern and document are printed concurrently or the digital patter is preprinted and the document then added, it is **the same printer performing both tasks.**

As the Examiner has failed to appreciate that it is the same printer providing both the digital pattern and the content, the Examiner has failed to appreciate the true nature of the unique identifier, which serves to correlate the electronic version of the content provided by the Second Printer with the digital paper as provided by the First Printer.

Moreover, **Euchner does not teach the digital pattern being provided by a first printer and the content being provided by a second printer**. As Euchner fails to teach a first and second printer, Euchner also fails to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content.

Coffy quite clearly teaches a system and method for using a digital pen for funds accounting devices and postage meters. Coffy teaches that the envelope has pre-printed embedded intelligence that can be read by the pen. Col 5, lines 1-10.

Coffy further teaches that *the pen is used by a user to write upon the envelope so as to indicate an address, class of postage and amount of intended postage.*

Coffy does not teach a second printer.

As Coffy fails to teach a first and second printer, Coffy also fails to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content (e.g. the user written information for address, class of postage, etc…).

The pen is described as having a processor and components enabling it to detect position and/or BIODATA – as a pen any and all ability to provide a mark is achieved by a human operator manipulating the pen in the exercise of drawing or writing. **This pen as taught by Coffy is not equivalent to the second printer as set forth in the present application, and Examiner is in error to do so**. To remove the pen and substitute a printer would clearly frustrate the purpose and teaching of Coffy as the human user would not be able to use a second printer in the same manner as a pen.

With respect to the references of Euchner and Coffy, the Examiner asserts that they are combinable simply because they each teach editing a hardcopy of a document through the use of an electronic pen. Such an assertion is unfounded and born from misunderstanding the nature and teachings of each references.

Whether or not Euchner and Coffy teach editing document with a pen is somewhat irrelevant. Both Euchner and Coffy teach **a printer – *not two printers***. Coffy does not undo the specific teaching of Euchner to use **the same printer for providing <u>both</u> the digital pattern <u>and</u> the hardcopy document**.

As the Examiner has failed to properly understand the teachings of Euchner and Coffy, the Examiner has failed to recognize at least the following minimum points of distinction:

1 – As neither Euchner nor Coffy teach the use of two printers, one specifically dedicated to providing the digital pattern and one specifically dedicated to

providing the content, their combined teachings can not be said to teach two distinct printers.

2 – As neither Euchner nor Coffy teach the use of two printers, their combined teachings fail to teach the use of an identity code.

3 – As neither Euchner nor Coffy teach the use of two printers, their combined teachings fail to teach transferring the identity code between the second printer and the printed sheet at around the time of printing the content.

These points of distinction are in no way resolved by the teachings of Korst. Korst is a printer application adapter system. Korst teaches how old legacy printers, for example dot matrix printers, requiring the specification of "DARK" when bold printing is desired can be used by a system that provides "BOLD" as the darkening command by recognizing the unsupported command and replacing it with a legacy command. More specifically, Korst teaches how a data stream directing "PRINT BOLD 'HELLO'" that would be unintelligible to the legacy printer becomes "PRINT DARK 'HELLO'" by replacing the unknown command.

Korst teaches nothing whatsoever regarding the use of two printers, let alone one printer to provide a digital pattern and a second printer to provide human-discernable content. As Korst fails to teach a first and second printer, Korst also fails to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content. At best Korst might be adapted to help control the second printer (e.g. a legacy printer) in the present invention, but even with such adaptation, Korst can in no way be found to teach the first and second printers or the transfer of machine-readable identity code between the second printer and the printed sheet at around the time of printing the content.

In light of the above summary of Euchner, Coffy and Korst it is respectfully submitted that the Examiner has failed to resolve the *Graham* factual inquiries by failing to properly ascertain the actual differences between the prior art references of Euchner and Coffy and at the very least claim 1, 12 and 52. Korst as added with respect to dependent claims 72-74 in no way resolves these actual differences.

Although other differences certainly exist, these are critical to the teachings of Euchner and Coffy and cannot be ignored. Indeed a large number of devices may exist in the prior art where, if the prior art is disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the Applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet Applicant's claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that the "decision maker must step

backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s). Respectfully, the March 26, 2008 Office Action has failed to meet this burden.

The guidelines under KSR echo this point, and evidence how and why Examiner's view of obviousness from the combination of references is unfounded.

For a combination of references to be proper there must be:

1 - a finding that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination.

This is not done – The claims of the present application clearly assert that there are two **printers** – one providing the pattern and a second providing content and in certain embodiments an identity code. Euchner does not teach two printers each performing a specific roll – one to provide the digital pattern and one to provide the content. Although Euchner suggests that multiple printers may be used, each can provide BOTH the digital pattern AND the content. Moreover, Euchner clearly and unambiguously teaches that, "***special printer is used to print both the digital paper and the document*** so that the electronic master document is associated with the printed hardcopy." Col 4, line 38-41. Coffy likewise teaches only one printer. Whether or not Euchner and Coffy teach editing of a hardcopy document is irrelevant and does not undo the specific teachings of Euchner for a single special printer.

As neither Euchner nor Coffy teach the use of two distinct printers performing distinct rolls, Euchner and Coffy when combined also fail to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content. Indeed, Euchner and Coffy fail to provide at least three key points of distinction cited above and claimed in the present invention.

Moreover, all of the claimed elements are not shown and the only difference is clearly not the lack of actual combination.

2 – a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately.

This is not so – Euchner and Coffy fail to provide all of the elements as presented by Applicant.

At least one missing element is a distinct first printer printing the digital pattern upon the paper and a distinct second printer printing human discernable content upon the pre-printed paper.

At least a second missing element is the identity code existing in addition to the digital pattern.

At least a third missing element is transferring the identity code between the second printer and the printed sheet at around the time of printing the content.

Spontaneous acquisition of missing elements is certainly not disclosed, and known methods as applied to the Euchner and Coffy disclosed elements would not provide them.

3 – a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable.

This is not so - The modifications required to Euchner and Coffy are so significant and contrary to the teachings, that the results are in no way predictable.

4 – any additional findings.

Respectfully, the Examiner has mischaracterized the references and the associated differences between the references and the present invention. Examiner's statement of "official notice" that the printer doing the printing of the pattern would have better resolution then the second printer is unfounded. There is simply no sustainable inference for a second printer let alone that the second printer would have lesser, greater or equal printing resolution. Only in the present application is the issue of the second printer specifically realized and that the second printer may have lesser resolution – e.g., a legacy or existing printer already in the workplace environment that would have to be replaced for the specialized printer as taught by Euchner. Further still, Korst offers nothing to resolve any of the above-identified factual differences. Indeed the mere fact that Korst presents a way of maintaining use of legacy printing equipment is no more an appropriate basis for combination then is the mere fact that Euchner and Coffy teach the use of a digital pen.

Respectfully, "***If the*** proposed ***modification or combination*** of the prior art ***would change the principle of operation*** of the prior art invention being modified, then ***the teachings*** of the reference ***are not sufficient*** to render the claims prima facie obvious." *In re Ratti* 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (comment added). Euchner specifically teaches a special printer providing both the pattern and the content. Coffy clearly teaches the pattern to be provided by a printer and then the pen to be used by a human operator to provide additional information and the pen is not and cannot be interchanged with the second printer as set forth in the present application.

Without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a prima facie case for obviousness. *See, KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ___ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...," *citing In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," *KSR* at 14).

As the *Graham* factual inquire is not properly resolved, application of any of the rationales (A)-(G) as set forth in the guidelines is futile for Euchner and Coffy, with or without Korst, fail to provide all of the claim elements as set forth in claims 1, 12 and 52, let alone these claims with their respective dependent claims.

More specifically, because the Examiner has failed to ascertain the actual differences between Euchner, Coffy and Korst and the presently described and claimed invention, Examiner's conclusion that Euchner, Coffy and Korst make obvious **all** of the features as recited in these claims is in error.

Claims 2-9 depend directly or indirectly from claim 1 and provide additional elements.

As demonstrated above, Euchner and Coffy fail to properly combine and teach all of the claim limitations present in independent claim 1, 12 and 52. The additional claim elements presented by the dependent claims only further enhance the distinctions between the present invention and the references of Euchner and Coffy. For example, as Euchner fails to teach two distinct printers, one first printer to provide the digital pattern and a separate and distinct second printer, the untaught second printer cannot be said to read any identity code (which is also not taught) from the sheet at the time content is printed upon the sheet (see Claims 2), or to print the identity code (which is not taught) upon the sheet (see Claim 3).

In addition, Claim 6 introduces that the second printer has a pattern reading device. Examiner cites to Col 4, lines 42-45 as evidence that Euchner also has a pattern reading device. Respectfully, this assertion is in error. The indicated passage has been cited above and can be easily reviewed. It is unquestionable that the passage states nothing what so ever with respect to a pattern reading device.

Moreover, because one (1) "special printer" is used to print both the digital pattern and the content, a pattern reading device is not required to permit recognition of the pre-printed paper and correlation of the identified paper with the content now being provided by a content printer.

Claims 13-19, 21 and 23-24 depend directly or indirectly from claim 12. These dependent claims provide similar additional limitations to those described above with respect to claim 1, and again in no way can be demonstrated to overcome the key shortcomings discussed at length above.

Additional limitations are also set forth, such as in claim 23 wherein the first printer is stated to have substantially better resolution then the second printer. As Euchner teaches the use of only a "***special printer is used to print both the digital paper and the document*** so that the electronic master document is associated with the printed hardcopy" it is a physical impossibility for the same single printing device to have two physically different resolutions. Respectfully, such a misperception serves to further emphasize the Examiner's failing to properly appreciate the unique and advantageous nature of the present invention.

Claim 72 depends from claim 1, claim 73 depends from claim 12 and claim 74 depends from claim 52. It is for these claims that Korst has been introduced. Again, as Euchner teaches that only a special printer is used to print both the digital paper and the document is mind bending to attempt a view wherein the one and only printer providing both the digital paper and the document is both a special printer and an existing legacy printer. Even if assumed to somehow be a special existing legacy printer, it would still be a single unitary printer. The type of legacy printers, e.g. dot matrix printers, as discussed by Korst are certainly not likely to be able to provide an Anoto type of digital pattern. And, even if possible, does not in any way undo the specific teaching of Euchner for a single special printer.

For at least these reasons the rejections of:

a.) Claims 1-9, 12-19, 21, 23, 24 and 52 under 35 U.S.C. §103(a), as being unpatentable over Euchner in view of Coffy is unfounded, does not satisfy the requirements of prima facie obviousness and should be reversed; and

b.) Claims 72-74 under 35 U.S.C. §103(a), as being unpatentable over Euchner in view of Coffy further in view of Korst is unfounded, does not satisfy the requirements of prima facie obviousness and should be reverse.

(8) Conclusion

For at least the reasons given above, the rejections of claim 1-9, 12-19, 21, 23, 24, 52 and 72-74 are improper. Accordingly, it is respectfully requested that such rejections by the Examiner be reversed and these claims allowed. Attached below for the Board's convenience is an appendix of claims 1-9, 12-19, 21, 23, 24, 52 and 72-74 as currently pending.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper.

Appellants believe that no fees are due in accordance with this Appeal Brief beyond those included herewith. Should any additional fees be due or an overpayment made, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account Number 08-2025, referencing the Attorney Docket Number 200208339-1.

Respectfully submitted,

Dated: June 29, 2009

By: 

Daniel W. Roberts, Reg. No. 52,172
The Law Offices of Daniel W. Roberts
904 Topaz Street
Superior, Colorado 80027
Telephone: 720-304-3026

(9) Claim Appendix

WHAT IS CLAIMED IS:

1. (Previously Presented) A method of associating in computer memory (i) a digital electronic version of printed human-discernible content of a printed document comprising a sheet having a machine-readable pattern adapted to enable the position of a digital pattern reading device to be determined and said human-discernible content with (ii) the identity of a sheet upon which the content is printed, the method comprising:

   printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed by a first printer with said pattern;

   transferring a machine-readable identity code between said second printer and said sheet at around the time of printing said content;

   and storing a correlation between said identity code and said digital electronic version in computer memory.

2. (Previously Presented) A method according to claim 1 wherein said identity code is read from said sheet by said second printer.

3. (Previously Presented) A method according to claim 1 wherein said identity code is printed on said sheet by said second printer.

4. (Previously Presented) A method according to claim 3 wherein a plurality of sheets have the same pre-printed pattern as provided by the first printer and are given individual identities by using said second printer to apply different machine-readable identity codes to each of them at around the time of printing each sheet.

5. (Original) A method according to claim 1 wherein said machine-readable identity code comprises at least one code from the group:

   (i) a pattern of dots;

   (ii) a pattern of lines;

   (iii) a pattern of printed objects whose positions and/or shapes code for an identity;

   (iv) a position determining pattern;

   (v) a bar code.

6. (Previously Presented) A method according to claim 1 wherein the second printer which prints said content onto said pre-patterned sheet has a pattern reading device, and wherein said second printer acquires data from said pre-printed pattern on the said sheet that is to be printed with content, in order to enable the identity of pattern on said sheet to be established, thereby enabling said association to be made in computer memory;

said second printer uses data from a digital electronic version of content to print said content onto said pre-patterned sheet;

and wherein said association is made in computer memory between said digital electronic version of said content and said identity of pattern.

7. (Previously Presented) A method according to claim 6 wherein said pre-printed pattern is associated in computer memory with specific digital electronic content and wherein upon recognition of said pattern using data acquired by said pattern reading device of said second printer, said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human-discernible content.

8. (Previously Presented) A method according to claim 7 wherein different users have different pattern associated with them and wherein upon recognition of their pattern from data from said second printer's pattern reading device said content printer is caused to print user-specific content onto said sheet.

9. (Original) A method according to claim 2 wherein said human-discernible content comprises document-type content and user-specific content, wherein one from the group:

(i) document-specific content; and

(ii) user-specific content is selected by a user, and the other from said group is obtained from a predetermined correlation between said identity code that has been read by said printer and a digital electronic version said content.

10 - 11. (Canceled)

12. (Previously Presented) A method of associating in computer memory a digital electronic version of printed human discernible content of a printed document with an identity code adapted to identify said document, the method comprising:

using a plurality of pages of pre-patterned digital paper that have been pre-printed by a first printer with a position-determining pattern, said pattern being adapted to enable a digital pen to acquire information from said pattern to enable the position of said pen on said pattern to be determined;

printing said content on said digital paper using a second printer;

using said second printer to be instrumental in conveying an identity code to or from the paper;

and associating in computer memory, using said code transferred, at the time of printing said content onto said pre-patterned paper, a digital electronic version of said content with the identity code for the particular sheet of digital paper upon which said content is printed.

13. (Original) A method as claimed in claim 12 wherein an identity code adapted to distinguish a specific sheet of pre-pattern digital paper is printed onto said specific sheet as part of an operation of printing said content onto said specific sheet, said identity code being readable by a digital pen and being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet.

14. (Previously Presented) A method according to claim 12 wherein an identity code adapted to distinguish a specific sheet of pre-patterned digital pattern is printed on said specific sheet in an operation prior to printing said content onto said specific sheet, and wherein a second printer which prints said content onto said pre-patterned paper has an identity code reading device, said second printer being capable of acquiring data from said identity code, said identity code being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet, to enable said association to be made between said digital electronic version of said content and said identity code.

15. (Original) A method according to claim 12 wherein a plurality of different identity codes are printed on a respective plurality of pre-patterned sheets each having the same pre-printed position-determining pattern, said identity codes enabling a digital pen to acquire sheet identity data to enable data acquired from each sheet to be distinguished from data acquired from other sheets.

16. (Previously Presented) A method according to claim 14 wherein said identity code is associated in computer memory with specific digital electronic content and wherein upon recognition of said identity code using data acquired by said identity code reading device of said second printer, said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human discernible content.

17. (Previously Presented) A method according to claim 16 wherein different users have different identity codes associated with them and wherein upon recognition of their identity code from data from said second printer's identity code reading device said second printer is caused to print user-specific content onto said sheet.

18. (Original) A method according to claim 12 wherein said identity code is printed in an area of said pre-patterned paper which is from the group:

(i) free of pattern;

(ii) substantially free of pattern.

19. (Original) A method according to claim 15 wherein an area of said sheets from the group:
(i) all of a surface of each of the sheets;
(ii) substantially all of a surface of each of the sheets;
(iii) at least half of the surface area of each of the sheets;
(iv) at least a tenth of the surface area of each of the sheets;
are pre-printed with pattern.

20. (Canceled)

21. (Previously Presented) A method according to claim 12 wherein said second printer is (i) not capable of printing said pattern satisfactorily; or (ii) configured not to be capable of printing said pattern satisfactorily.

22. (Canceled)

23. (Previously Presented) A method according to claim 1 wherein said first printer has substantially better print resolution than does said second printer.

24. (Original) A method according to claim 23 wherein pre-printed digital paper is taken from said first printer and put into a plurality of second printers.

25 – 51 (Canceled)

52. (Previously Presented) A method of combining pen strokes made with a digital pen upon a digital sheet having pen position-determining pattern printed upon it and human-discernible content printed upon it comprising:
printing said sheet with said pattern in a pre-patterning operation with a first printer to create a pre-patterned sheet;
subsequently printing said content onto said pre-patterned sheet using a second printer to create a content-printed digital sheet;
transferring an identity code between said second printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet;
associating in computer memory a link between said identity code and an electronic version of said content that was printed on said sheet;
using a digital pen to make pen strokes on said content-printed sheet;

conveying pen-acquired pen-position data, relating to the position of said pen in said pattern to a processor;

using the digital pen to acquire said identity code from said content-printed sheet;

the processor using the pen-acquired identity code, the pen acquired pen-position data, and the link between said identity code and said electronic version of said content to combine said pen strokes with said content.

53 - 71. (Canceled)

72. (Previously Presented) The method according to claim 1, wherein the second printer is an existing legacy printer.

73. (Previously Presented) The method as claimed in claim 12, wherein the second printer is an existing legacy printer.

74. (Previously Presented) The method as claimed in claim 52, wherein the second printer is an existing legacy printer.

(10) Evidence Appendix

None

(11) Related Proceedings Appendix

None